

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, claims 1, 2, 4, 10-17, 19, 21, 29-35, 37, 39 and 40 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 3-9, 18, 20, 23-28, 36, 38 have been amended. Also, claims 41-42 have been added. Claims 3, 5-9, 18, 20, 22-28, 36, 38 and 41-42 are thus pending in the present application.

No new matter has been added with the amendment to the claims. The various claims have been amended to delete the term "hydrate." Also, the A¹, X¹, Y¹ and/or E groups of claims 3, 18 and 23-25 have been redefined. Also, provisos (1), (2), (3) and (5) in claim 3 has been deleted since E has been limited to a thiaryl group and an aryloxy group has been deleted from <substituent group a-1> and <substituent group a-2> of A¹. Applicants note that claims 6 and 7 properly depend on claim 5 (which recites the substituent groups c-1 and c-2). Further, claim 18 is now in independent form. Claims 20 and 23 have been amended to depend on claim 18. Each of claims 24-25 now depend on claim 23 since substituent groups g-1 and g-2 are recited in claim 23. The now recited substituent group d in claim 26 is taken from claim 5. New claim 41 is similar to claim 36 but depends on independent 18. Other minor amendments have also been made (e.g. parenthesis being deleted). Such amendments are clarifying in nature and not narrowing in scope. By deleting/amending these terms in order to clarify the claimed invention

(e.g., “Substituent” to “substituent”), Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Election/Restriction

Applicants respectfully refer the Examiner to the claims as shown herein. For instance, the definitions for the A¹, X¹, Y¹ and E groups of claim 3 have been amended. Applicants also respectfully rejoinder of withdrawn claim 38, wherein it is believed that claim 3 is now in allowable condition.

Issues under 35 U.S.C. § 102(b)

Claims 1-9, 16-28, 36 and 37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fancelli et al. (U.S. Patent No. 6,414,013; hereinafter “Fancelli ‘013”), Yoshikawa et al. (U.S. Patent No. 5,747,518; “Yoshikawa ‘518”) or Marfat et al. (U.S. Patent No. 6,380,218¹; “Marfat ‘218”). Applicants respectfully traverse. Reconsideration and withdrawal of these rejections is respectfully requested.

A prior art reference is anticipatory under 35 U.S.C. § 102(b) if it discloses each and every element of a claimed invention, either explicitly or inherently, and if it enables person of

ordinary skill in art to make invention without undue experimentation. *In re Gleave*, 560 F.3d 1331, 90 USPQ2d 1235, 1238 (Fed. Cir. 2009). But this is not case, wherein Applicants respectfully refer the Examiner to the disputed claims as shown herein.

First, some of the claims have been canceled, thereby rendering the rejection of these claims moot.

Second, regarding the remaining claims, the cited references do not disclose all claimed features. For instance, regarding Marfat '218, a "C₆₋₁₀ arloxy group" is no longer a part of the Markush groups that define the a-1 and a-2 groups in claim 3. Applicants also note that claims 1 and 2 have been canceled. Also, it is believed that any cited overlap with Fancelli '013 and Yoshikawa '518 has been eliminated.

Thus, reconsideration and withdrawal of these rejections are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 1-9, 16-28, 36 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Fancelli '013, Yoshikawa '518, and Marfat '218. Applicants respectfully traverse.

As the M.P.E.P. directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* M.P.E.P. § 2143.03. As explained above, the cited references fail to disclose all claimed features. Thus, the comments in the Office Action regarding homologs do not apply to the instant claims.

¹ U.S. Patent No. 6,630,218 is cited in the Office Action; Applicants believe this number to be in error.

Further, as stated in M.P.E.P. § 2143.02, the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In finding a reasonable expectation of success, at least some degree of predictability is required. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (Claims directed to a method for the commercial scale production of polyesters in the presence of a solvent at superatmospheric pressure were rejected as obvious over a reference which taught the claimed method at atmospheric pressure in view of a reference which taught the claimed process except for the presence of a solvent. The court reversed, finding there was no reasonable expectation that a process combining the prior art steps could be successfully scaled up in view of unchallenged evidence showing that the prior art processes individually could not be commercially scaled up successfully.). But there is no such predictability in the art. If anything, there is unpredictability in the art such that the skilled artisan could not predict the properties of a given compound (see, e.g., page 7 , last paragraph of the Office Action).

Based on the present amendments and arguments, reconsideration and withdrawal of this rejection is respectfully requested.

Issues under 35 USC § 112, First Paragraph

Claims 1, 3-9, 16-28, 36 and 37 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description and enablement requirements. Applicants respectfully traverse.

Only as an effort to advance prosecution, Applicants note that “hydrates” have been deleted. Thus, these rejections have been rendered moot. Reconsideration and withdrawal of these rejections are respectfully requested.

Issues under 35 USC § 112, Second Paragraph

Claims 1, 3-9, 16-28, 36 and 37 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants respectfully traverse.

Only as an effort to advance prosecution, Applicants note that “hydrates” have been deleted. Also, the word “may” has been deleted throughout the claims. Further, claim 36 has been amended to recite a pharmaceutically acceptable carrier. Finally, claim 37 has been canceled.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Double Patenting Rejection

Claims 1-9, 16-28, 36 and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 11/658,903.

Applicants respectfully traverse and request reconsideration in light of the amendments to the claims in the present application. Otherwise, Applicants request this provisional rejection be held in abeyance until the cited copending or this application issues as a patent.

Conclusion

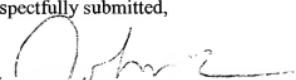
In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Reg. No. 48,501 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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